
REMARKS

Remarks Regarding Notice of Non-Compliant Amendment

Applicants thanks Examiner Harmon, Supervisor Rada, and Legal Instruments Examiner Cobb for their assistance in addressing the Notice of Non-Compliant Amendment ("NNCA"), which was mailed from the U.S.P.T.O. on October 9, 2003. The NNCA pertained to Applicants' Amendment and Response, which was filed on September 26, 2003 and accompanied by an RCE.

In the Office Action of August 8, 2001 (i.e., the first Office Action pertaining to Applicants' application), claims 10-34 and 37 were made subject to a restriction requirement and were withdrawn from further consideration by the Examiner. The Amendment and Response of September 26, 2003 listed claims 10-34 and 37 as being withdrawn, which is what Applicants intended. However, the previous Amendment, which was filed June 19, 2003 in response to the Office Action of February 11, 2003, erroneously listed claims 10-34 and 37 as being canceled. Because of this inconsistency, the NNCA was issued.

This Preliminary Amendment is intended to be fully responsive to the Final Office Action of July 31, 2003 and is intended to replace the Amendment and Response of September 26, 2003 in its entirety. As directed by Supervisor Rada, claims 10-34 and 37 are once again listed as canceled.

It should be noted that Applicants never intended the cancellation of claims 10-34 and 37 and no prejudice should be attributed to these claims. The original listing of the claims as canceled was an inadvertent mistake. Applicants respectfully request leave to add the canceled claims without prejudice at a later time, in this or a continuing application.

Remarks Regarding Final Office Action of July 31, 2003

Applicants submit these remarks in response to the Final Office Action of July 31, 2003. In the Final Office Action, newly added claims 41-50 were subjected to an election/restriction requirement and were withdrawn by the Examiner for being directed to a non-elected invention.

In the Final Office Action, the Examiner rejected claims 1-5, 35-36, and 38-40 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,179,866 to Graham et al. ("Graham"). The Examiner also rejected claims 6-9 under 35 U.S.C. § 103(a) as being obvious over Graham in view of U.S. Patent 4,550,549 to Reinfeld et al. ("Reinfeld").

In this amendment, Applicants amend claims 1-4 and 35 and offer arguments distinguishing the claims from the cited references, thereby overcoming the claim rejections. Applicants respectfully submit that claims 1-9, 35-36 and 38-40 are patentable over the prior art of record. Accordingly, Applicants request a notice of allowance.

35 U.S.C. § 102(b) Rejections of Claims 1-5, 35-36, and 38-40

The Examiner rejected claims 1-5, 35-36, and 38-40 under 35 U.S.C. § 102(b) as being anticipated by Graham. A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. MPEP § 2131.

Independent claim 1 recites, "[a]n apparatus for packaging goods in an open-bottomed box erected from a flat-folded configuration to receive at least one good, the open-bottomed box having sidewalls that define a bottom opening and wherein the bottom opening does not have flaps for closing the bottom opening" Similarly, independent claim 35 recites, "[a] method for packaging goods in an open-bottomed box having sidewalls that define a bottom opening and wherein the bottom opening does not have flaps for closing the bottom opening,"

Unlike independent claims 1 and 35, Graham discloses a box “with opposed lower side flaps 16 and front and rear flaps 17, 18 which depend downwardly from the upright walls 12, 13.” *Graham specification, col. 2, ll. 15-17*. Thus, Graham does **not** disclose, teach or suggest an apparatus or a method “for packaging goods in an open-bottomed box ... having sidewalls that define a bottom opening and wherein the bottom opening **does not have flaps**.” For at least this reason, Graham fails to anticipate each and every element as set forth in independent claims 1 and 35. Since claim 36 depends on independent claim 35, and claims 2-9 and 38-40 depend on independent claim 1, Graham also fails to anticipate these claims as well. Therefore, Applicants respectfully request that the anticipation rejection be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections of Claims 6-9

The Examiner rejected claims 6-9 under 35 U.S.C. § 103(a) as being obvious over Graham in view of Reinfeld. In order for a combination of references to establish a case of prima facie obviousness, three requirements must be met:

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art references when combined must teach or suggest all the claim limitations.

MPEP §2142.

As explained in the preceding section, Graham does not disclose, teach, or suggest “[a]n apparatus for packaging goods in an **open-bottomed box erected from a flat-folded configuration ... wherein the [box] does not have flaps** for closing the bottom opening.” This is an element of independent claim 1, which is the claim on which claims 6-9 depend. Reinfeld

does not remedy the deficiencies of Graham. Therefore, the Graham/Reinfeld combination fails to teach or suggest all of the limitations recited in claims 6-9. As a result, Applicants respectfully request that the obviousness rejection be reconsidered and withdrawn.

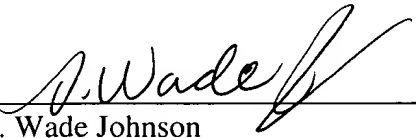
CONCLUSION

In view of the preceding remarks, Applicants respectfully urge that the Examiner's rejections be reconsidered and withdrawn, and that claims 1-9, 35-36 and 38-40 be allowed. However, if the Examiner believes that any issues remain unresolved, the Examiner is invited to telephone the undersigned to expedite allowance.

It is believed no fees are due in connection with this communication. However, the Office is hereby authorized to charge any fees associated with this communication to Deposit Account 04-1420.

Respectfully submitted,
DORSEY & WHITNEY LLP
Customer Number 25763

Date: 11-6-03

By: 
S. Wade Johnson
Reg. No. 50,873
Intellectual Property Department
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402-1498
(612) 340-8835